

Serial No. 10/733,380
Docket No. FJ-2003-046-US
(MAS.018)

1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Koki Okamura

Serial No.: 10/733,380

Group Art Unit: 2164

Filed: December 12, 2003

Examiner: Sathyanaraya R. Pannala

For: FILE TRANSFER PROGRAM

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

STATEMENT OF SUBSTANCE OF THE INTERVIEW

Sir:

Please review and enter the following remarks summarizing the telephonic interview conducted on December 27, 2006:

REMARKS

As a preliminary matter, Applicant's representative would like to thank the Examiner for courtesies extended in the telephone interview conducted on December 27, 2006.

An Examiner's Interview Summary Record (PTOL-413) was mailed by the Examiner on January 5, 2007.

Applicant submits this Statement to comply with the requirements of M.P.E.P. § 713.04.

In the interview, the following was discussed:

A. Identification of claims discussed:

Claims 1-14.

Serial No. 10/733,380
Docket No. FJ-2003-046-US
(MAS.018)

2

B. Identification of rejections discussed:

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allam in view of Pruett.

C. Identification of principal proposed amendments:

None.

D. Brief Identification of principal arguments:

In the Response to Arguments of the present Office Action, the Examiner states that the "declaration filed on 9/5/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Allam (USPA Pub. 2004/0139400) reference because of the following reasons:

- The proposed reply filed on 9/5/2006 has not been entered because it is unsigned.
- The declaration does not contain the invention disclosure statement correlating to the claims.
- The declaration does not contain explanation of the contents of the invention disclosure document."

1) First, Applicant's representative noted that the Amendment filed on September 5, 2006 specifically noted that the un-executed declaration under 37 C.F.R. § 1.131 was being filed to expedite the Examiner's consideration of the application, and that the executed declaration would be filed upon receipt from the inventor (see Amendment under 37 C.F.R. § 1.111 filed on September 5, 2006, at page 11, lines 4-8).

Accordingly, the executed Declaration under 37 C.F.R. § 1.131 was filed in the USPTO via facsimile on November 14, 2006, as evidenced by the PTO facsimile filing

Serial No. 10/733,380
Docket No. FI-2003-046-US
(MAS.018)

3

receipt, and the "Transaction History" and "Available Documents" obtained from the USPTO PAIR site.

As indicated on the PAIR site, Applicant's representative noted that the present Office Action was entered on November 24, 2006, and mailed on November 27, 2006, which was after the filing of the executed Declaration under 37 C.F.R. § 1.131 on November 14, 2006.

Thus, the Examiner properly should have entered and considered the executed Declaration, which was filed on November 14, 2006, prior to issuing the present Office Action.

Indeed, since the un-executed Declaration and the executed Declaration were identical, except for the inventors' signatures, sufficient time clearly was available to enter and consider the executed Declaration prior to entering the Office Action on November 24, 2006, and subsequently mailing the same on November 27, 2006.

It was noted that the Examiner has considered the content of the unexecuted Declaration, although the subsequently filed executed Declaration was not entered.

2. Second, with respect to the Examiner's allegation that the "declaration does not contain the invention disclosure statement correlating to the claims," it was noted that the Declaration under 37 C.F.R. § 1.131 clearly includes a statement that the inventor is the sole inventor of the above-identified application (see Declaration under 37 C.F.R. § 1.131, at numbered paragraph (1)). Clearly, since Applicant is the sole inventor of the present application, the Applicant is the sole inventor of all of the claims of the present application.

Moreover, Applicant's representative pointed out that paragraph 5 of the Declaration clearly states that:

Serial No. 10/733,380
Docket No. FJ-2003-046-US
(MAS.018)

4

5) The contents of the enclosed "Invention Disclosure Documents" (Exhibit 1) have been incorporated into the specification of the present invention, upon which claims 1-14 are based.

Moreover, Applicant's representative argued that all of the requirements for filing a Declaration under 37 C.F.R. § 1.131 have been met by the present Declaration (c.g., see 37 C.F.R. § 1.131; see also 37 C.F.R. § 1.68; see also M.P.E.P. § 715).

It is noted that 37 C.F.R. § 1.131 states that:

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e).

...

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

That is, Applicant must show invention of the subject matter of the rejected claims. In this case, the Exhibits submitted with the Declaration show invention of the subject matter of the rejected claims.

Applicant is not aware of a requirement that an invention disclosure statement that explicitly identifies the rejected claims must be made for the Declaration under 37 C.F.R. § 1.131 to be effective.

In the interview, Applicant's representative requested that, should the Examiner consider this statement to be a requirement of a Declaration under 37 C.F.R. § 1.131, the

Serial No. 10/733,380
Docket No. FJ-2003-046-US
(MAS.018)

5

Examiner is requested to identify the basis for this requirement in the applicable law, rules, or procedures.

3. Third, in response to the Examiner's allegation that the "declaration does not contain explanation of the contents of the invention disclosure document," it was noted that a full English language translation of the Invention Disclosure Document was submitted as Exhibit 2, together with the Declaration.

Thus, it is unclear what explanation of the contents of the invention disclosure document that the Examiner considers to be missing from the Declaration.

In the interview, Applicant's representative requested that, should the Examiner consider this statement to be a requirement of a Declaration under 37 C.F.R. § 1.131, the Examiner is requested to identify the basis for this requirement in the applicable law, rules, or procedures.

4. For the foregoing reasons, Applicant submitted that the Declaration under 37 C.F.R. § 1.131 filed on November 14, 2006 properly should have been entered by the Examiner.

Moreover, Applicant submitted that the Allam reference should be removed as prior art, since Applicant has perfected the claim to foreign priority and properly filed a Declaration under 37 C.F.R. § 1.131 showing invention of the subject matter of the present application prior to the effective filing date of the Allam reference.

Applicant reiterated that the § 102(e) date of October 23, 2002 of Allam is one (1) month and twenty (20) days prior to the filing date of the present application's Japanese priority document on December 13, 2002.

Therefore, Allam should be removed as prior art under 35 U.S.C. § 102(e) because Applicant (1) perfected the claim to foreign priority based on JP 2002-361998, which was

Serial No. 10/733,380
Docket No. FJ-2003-046-US
(MAS.018)

6

filed on December 13, 2002, by the filing a verified English translation thereof on September 5, 2006; and (2) filed the executed Declaration under 37 C.F.R. § 1.131 which properly swears behind the critical date (i.e., October 23, 2002) of Allam, by establishing invention of the subject matter of the present application before the Allam reference's effective § 102(e) prior art date of October 23, 2002.

Applicant submitted that the Declaration properly swears behind the effective prior art date of the Allam reference by establishing a reduction to practice prior to the effective date of the Allam reference, or in the alternative, conception of the invention, coupled with due diligence from just before the effective date of the Allam reference up to the constructive reduction to practice of the present application by the filing of the JP 2002-361998 priority document.

For the foregoing reasons, Applicant reiterated that the Allam reference should be removed as prior art and the Examiner is requested to withdraw these rejections and to permit these claims to pass to immediate allowance.

E. Results of the Interview:

No agreement was reached.

F. Conclusion:

The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

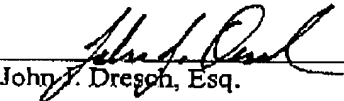
Serial No. 10/733,380
Docket No. FJ-2003-046-US
(MAS.018)

7

It is believed that no petition or fee is required. However, if the USPTO deems otherwise, the Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 1/26/07


John F. Dresch, Esq.
Registration No. 46,672

Sean M. McGinn, Esq.
Registration No. 34,386

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November 14, 2006

VIA FACSIMILE
(Total No. of Pages Transmitted: 13)

To: Examiner Robinson, R. Pinnola
Group Art Unit 3164
U.S.P.T.O.

Facsimile No.: 571-273-8300

From: John J. Drech, Esq.

Facsimile No.: 703-761-2376

Re: Enclosed Submission of Declaration under 37 C.F.R. § 1.131, Exhibit 1,
and Exhibit 2 (English translation)
U.S. Patent Application No.: 10,700,040
Attorney Docket No.: PJ2005-0-6-US
Our Reference: N/A5,918

Dear Examiner Pinnola:

Enclosed for filing is a Submission of Declaration under 37 C.F.R. § 1.131, Exhibit 1,
and Exhibit 2 (English translation), in the above-referenced application, which is believed to
place the application in condition for allowance.

Thank you in advance for your kind consideration on this case.

Very truly yours,
John J. Drech, Esq.
John J. Drech, Esq.
Registration No. 46,677

ADD:MMN
Enclosure

PAGE 10 * ACVE AT 11/14/2006 4:17:01 PM (Eastern Standard Time) * SVR:USPTO-EFXXF-2/20 * DNIS:2738300 * CSID:7037612376 * DURATION (mm-ss):08-30

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November 14, 2006

VIA FACSIMILE

(Total No. of Pages Transmitted: 13)

To: Examiner Sathyanaraya R. Pannala
Group Art Unit: 2164
U.S.P.T.O.

Facsimile No.: 571-273-8300

From: John J. Dresch, Esq.

Facsimile No.: 703-761-2375


Re: **Enclosed Submission of Declaration under 37 C.F.R. § 1.131, Exhibit 1,
and Exhibit 2 (English translation)**
U.S. Patent Application No.: 10/733,380
Attorney Docket No.: FJ-2003-046-US
Our Reference: MAS.018

Dear Examiner Pannala:

Enclosed for filing is a **Submission of Declaration under 37 C.F.R. § 1.131, Exhibit 1,
and Exhibit 2 (English translation)**, in the above-referenced application, which is believed to
place the application in condition for allowance.

Thank you in advance for your kind consideration on this case.

Very truly yours,


John J. Dresch, Esq.
Registration No. 46,672


JJD/SMM
Enclosure

Serial No. 10/733,380
Docket No. FJ-2003-046-US
(MAS.018)

2

CERTIFICATE OF TRANSMISSION

I certify that I transmitted via facsimile to (571) 273-8300 the enclosed **Submission of Declaration under 37 C.F.R. § 1.131, Exhibit 1, and Exhibit 2 (English translation)**, to Examiner Sathyanaraya R. Pannala, Art Unit 2164, on November 14, 2006.


John J. Dresch, Esq.
Registration No. 46,672
Sean M. McGinn, Esq.
Registration No. 34,386

JAN 26 2007

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January 26, 2007

VIA FACSIMILE
(Total No. of Pages Transmitted: 36)

To: Examiner Sathyanaraya R. Pannala
Group Art Unit: 2164
U.S.P.T.O.

Facsimile No.: 571-273-8300

From: John J. Dresch, Esq.

Facsimile No.: 703-761-2375

Re: **Enclosed Request for Reconsideration under 37 C.F.R. § 1.116, and Statement of Substance of the Interview**
U.S. Patent Application No.: 10/733,380
Attorney Docket No.: FJ-2003-046-US
Our Reference: MAS.018

Dear Examiner Pannala:

In response to the final Office Action dated November 27, 2006, in the above application, enclosed for filing is:

- 1) a Request for Reconsideration under 37 C.F.R. § 1.116,
- 2) copies of the previously filed executed Declaration under 37 C.F.R. § 1.131 and Exhibits, and copies of the USPTO PAIR information for the present application, and
- 2) a Statement of Substance of the Interview,

which is believed to place the application in condition for immediate allowance.


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Serial No. 10/733,380
Docket No. FJ-2003-046-US
(MAS.018)

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Thank you in advance for your kind consideration on this case.

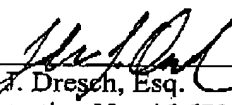
Very truly yours,


John J. Dresch, Esq.
Registration No. 46,672

JJD/SMM
Enclosures

CERTIFICATE OF TRANSMISSION

I certify that I transmitted via facsimile to (571) 273-8300 the enclosed Request for Reconsideration under 37 C.F.R. § 1.116, and copies of the previously filed Declaration under 37 C.F.R. § 1.131 and Exhibits, and PTO PAIR information, to Examiner Sathyanaraya R. Pannala, Art Unit 2164, on January 26, 2007.


John J. Dresch, Esq.
Registration No. 46,672
Sean M. McGinn, Esq.
Registration No. 34,386